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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/042,844	11/19/2001	Mark David Siegel	23679-7005	4461

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EXAMINER
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ENATSKY, AARON L

ART UNIT	PAPER NUMBER
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3713

DATE MAILED: 07/08/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/042,844

Applicant(s)

SIEGEL ET AL.

Examiner

Aaron L Enatsky

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 26 April 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-17 and 23-29 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-17 and 23-29 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 08 December 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)             | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                                    |

## **DETAILED ACTION**

### ***Response to Amendment***

Examiner acknowledges receipt of amendment on 4/26/04 as a response to a restriction requirement. Applicant elected claims 1-17 and 23-29 and cancelled claims 18-22.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 25-26 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Applicant requires that a case has a color and logo selected by a controller. Examiner does not believe that it is possible to change a case logo or color by a controller. The case is typically a static plastic device that can sometimes be manually swapped out for different colors/designs. As such, Examiner is interpreting Applicant's claim as a screen as part of the "case" which can display a logo or color selectable by a processor/controller.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 6, 12, and 14-16 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Applicant claims a gaming device, but also describes a method of correlating bar codes to game data. Applicant needs to clarify language to claim either a method or an apparatus. Applicant's language will be treated as structure as a look-up table since the dependency stems from an apparatus claim. Similarly, claims 12 and 16 suffer from a method on conducting a game, imposed in an apparatus claim.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-6, 12-17, 23-25, and 27-29 are rejected under 35 U.S.C. 102(e) as being anticipated by US 6,398,651 to Yamada. Yamada teaches a gaming device for playing a card game wherein the cards contain abilities of characters within the game (Abstract). Yamada teaches that new cards can be inputted into the system by way of an external card with a barcode (16:61-17:10). Thus, Yamada teaches that the game device can have a scanner and a processing means for capturing the data from the bar code. The cards contain data relating to game characters and their attributes and capabilities (7:24-32).

Claim 2: Yamada teaches game data comprising game characters (7:24-32).

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Claim 3: Yamada teaches the game devices as handheld gaming devices (Fig. 1A).

Claim 4: Yamada teaches the game device with a bar code scanner, thus the scanner would have LED's.

Claim 5: Yamada teaches a game screen and controls (Fig. 1A and 1B).

Claim 6: Yamada teaches a look-up table with refers to game data (6:6-14).

Claim 12, 14-16: Yamada teaches providing a contest on a game screen between a computer or another player (9:29-36), game data can correspond to enemy characters as displayed in a contest (9:30-45), and the contest is a battle (9:37-45).

Claim 13: Yamada teaches a communication port in a game machine (Fig. 1B and 3).

Claim 17: Yamada teaches interconnected game machines (Fig. 1B and 3). The first connector, second slot, and plurality of contacts are inherent in the use of a communication port and connection between another game machine.

Claim 23 and 29: Yamada teaches a handheld game machine (Fig. 1A), a scanner with one LED for reading bar codes (16:61-17:10), a controller (Fig. 3, 26), storage devices (Fig. 3, 30 and 28), and a network-coupling device (Fig. 3, 50).

Claim 24: Yamada teaches interconnected game machines (Fig. 1B and 3). The first connector, second slot, and plurality of contacts are inherent in the use of a communication port and connection between another game machine.

Claim 25: Yamada teaches a screen that has a logo associated with a game character (Fig. 9).

Claim 27: Yamada teaches a screen and a plurality of control on the same side of a case (Fig. 1A).

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Claim 28: Yamada teaches a coupling device on another side of the case (Fig. 1B).

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 7-10, 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yamada.

Claims 7-10: Yamada teaches the limitations described above including a game card having bar code data for game play, but does not teach the specific type of bar code encoding used for the bar code. However, the requirement of various different types of bar code encoding such as EAN, UPC, GTIN, GLN are functional equivalents and are merely a function of what would be considered common practice in a particular global location. For instance, the game located in the US would most likely use the UPC, since the UPC is the standard bar code encoding format used in the US. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to encode the bar code format depending on the specific location used for game distribution and execution.

Claim 26: Yamada teaches the limitations described above, but does not teach that the game screen is color. However, as typified in a common commercial portable game device as described by Yamada, the screen is often color. Color is a well-established method to add greater entertainment value to a game device, thus obvious to one of ordinary skill to use color in a portable game machine.

Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Yamada as applied to claims 1-10 above, and further in view of US 5,212,368 to Hara. Yamada teaches the game device as described above, but does not teach a speaker. However, as typified in a common commercial portable game device as described by Yamada, the game machine will have a speaker for sound output to provided music and game feedback. As further evidence, Hara teaches a portable game machine using cards and a card scanner to accept bar code input game data (Fig. 1) that uses a speaker to provide game output feedback (2:51-54). Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made provide a speaker in the portable game machine taught by Yamada to provide commonly outputted game sound data.

***Citation of Pertinent Prior Art***

US 6,165,068 to Sonoda et al. teaches a handheld game system with network connectivity.

US 6,315,669 to Okada et al. teaches portable color, handheld game system with network connectivity.

US 6,200,216 to Peppel teaches an electronic trading card game system.

US 2002/0022523 to Dan et al. teaches a game system using bar codes in a character growing game.

US 2002/0090985 to Tochner et al. teaches a virtual character gaming system with bar code data capture.

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***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Aaron L Enatsky whose telephone number is 703-305-3525. The examiner can normally be reached on 8-6 M-Th.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Derris Banks can be reached on 703-308-1745. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

ALE

**JOHN M. HOTALING, II**  
**PRIMARY EXAMINER**

